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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/084,712
Filing Date: February 25, 2002
Appellant(s): AGNIHOTRI ET AL.

Terri W. Kramer
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed July 22, 2007 appealing from the Office action mailed January 26, 2007.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

A. Rejection of Claims 1-5, 8[[-]], 11, 11, 13-16, 20 and 21 under 35 U.S.C. § 103(a) (note that the hyphen between 8 and 11 should be replaced with a comma since Claim 9 is rejected under another ground of rejection - see following paragraph C. – and Claim 10 is canceled).

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

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(8) Evidence Relied Upon

U.S. Patent No. 6,756,997 to Ward III et al. (“Ward”)

U.S. Patent No. 6,263,507 to Ahmad (“Ahmad”)

U.S. Patent No. 6,240,555 to Shoff et al. (“Shoff”)

(9) Grounds of Rejection

A. Claims 1-5, 8 and 20 and 21 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,756,997 to Ward III et al. (“Ward”) in view of U.S. Patent No. 6,263,507 to Ahmad (“Ahmad”).

Claims 1 and 20

Ward discloses a method and a corresponding video processing system comprising:

connecting to web site including information about a television program

being watched (see at least 18:19-34);

downloading the information from the website (see at least 18:19-34);

processing the information (see at least 18:19-34);

displaying the information along with the television program being

watched (see at least 18:19-34).

Ward does not specifically disclose the processing the information to *include[e]* *combining summaries of other episodes*. However, in an analogous art Ahmad discloses news summaries of different episodes (e.g., Insure’s Eye Erin’s Costs on Thu, 3 Aug 95 and Erin: QA Tropical Storm on Wed, 2 Aug 95) of a main series of event, which is the Erin tropical storm (see at least FIG. 2B).

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the supplemental information method of Ward using the summary combining of Ahmad for the purpose of allowing a body of information to be displayed by electronic devices in a manner that allows the body of information to be reviewed quickly and in a flexible manner.

Claim 2

The rejection of base claim 1 is incorporated. Ward further discloses *where the information about the television program is selected from the group consisting of textual information, audio information, video information and applications* (see at least 18:19-34).

Claim 3

The rejection of base claim 1 is incorporated. Ward further discloses *where the information about a television program is selected from the group consisting of a particular item in the program, a particular event, a character's role in the program, a history of the program, a summary of other episodes of the program, individual summaries of other episodes and similar events in other episodes* (see at least 18:19-34).

Claim 4

The rejection of base claim 1 is incorporated. Ward further discloses *where the connecting to the web site includes using a mechanism selecting from the group consisting of a*

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tag from an electronic program guide that correspond to the television program being watched, a search engine and a predetermined address of a website (17:54-65).

Claim 5

The rejection of base claim 1 is incorporated. Ward further discloses *wherein downloading the information from the website includes:*

extracting the information from the website (18:19-34); and

transmitting the information over a network (see at least 18:19-34).

Claim 8

The rejection of base claim 1 is incorporated. Ward does not specifically disclose *wherein processing the information includes combining video clips of events in other episodes to an event in the television program being watched.* However, in an analogous art Ahmad discloses three single video images that each represents a news story from a news program and that are displayed on one common screen (see at least FIG. 2B, item 213 and 17:1-3).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the supplemental information method of Ward using the summary combining of Ahmad for the purpose of enabling a user to control the display of an audiovisual news program by causing a summary of one or more news stories to be displayed.

Claim 21

Ward discloses a method comprising:

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connecting to web site including information about a television program being watched (see at least 18:19-34);

downloading the information from the website (see at least 18:19-34);

processing the information (see at least 18:19-34);

displaying the information along with the television program being watched (see at least 18:19-34).

Ward does not specifically disclose *wherein processing the information includes combining video clips of events in other episodes to an event in the television program being watched*. However, in an analogous art Ahmad discloses three single video images that each represents a news story from a news program and that are displayed on one common screen (see at least FIG. 2B, item 213 and 17:1-3).

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the supplemental information method of Ward using the summary combining of Ahmad for the purpose of enabling a user to control the display of an audiovisual news program by causing a summary of one or more news stories to be displayed.

Claim 11

The rejection of base claim 21 is incorporated. Since Claim 11 recites the same feature of combining summaries of other episodes recited in Claim 1, the same rejection is thus applied.

Claim 13

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The rejection of base claim 21 is incorporated. Since Claim 13 recites the same feature of Claim 2, the same rejection is thus applied.

Claim 14

The rejection of base claim 21 is incorporated. Since Claim 14 recites the same feature of Claim 3, the same rejection is thus applied.

Claim 15

The rejection of base claim 21 is incorporated. Since Claim 15 recites the same feature of Claim 4, the same rejection is thus applied.

Claim 16

The rejection of base claim 21 is incorporated. Since Claim 16 recites the same feature of Claim 5, the same rejection is thus applied.

B. Claims 6 and 17 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,756,997 to Ward III et al. (“Ward”) in view of U.S. Patent No. 6,263,507 to Ahmad (“Ahmad”), as applied to the base claim, and further in view of U.S. Patent No. 6,240,555 to Shoff et al (“Shoff”).

Claim 6

The rejection of the base claim 1 is incorporated. The combined Ward-Ahmad does not specifically disclose *wherein downloading the information from the website includes:*

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identifying information about events in other episodes similar to an event in the television program being watched;

extracting the information about events in other episodes from the website;

and

transmitting the information about events in other episodes over a network.

However, in an analogous art, Shoff discloses the identifying step (see at least 5:60-64; 11:28-34; 7:25-50); the extracting step (see at least 6:23-48); and the transmitting step (see at least FIG. 2; FIG. 4, items 74, 82; and 4:36-55) as claimed.

It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the supplemental information method of Ward-Ahmad using the episode information extraction method of Shoff for the purpose of supplying supplemental information to enhance the traditional way of viewing television.

Claim 17

The rejection of base claim 21 is incorporated. Since Claim 17 recites the same features of Claim , the same rejection is thus applied.

C. Claim 9 is rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 6,756,997 to Ward III et al. (“Ward”) in view of U.S. Patent No. 6,240,555 to Shoff et al (“Shoff”).

Claim 9

Ward discloses a method comprising:

connecting to web site including information about a television program being watched (see at least 18:19-34);

downloading the information from the website (see at least 18:19-34);

processing the information (see at least 18:19-34);

displaying the information along with the television program being watched (see at least 18:19-34).

Ward does not specifically disclose *wherein downloading the information from the website includes:*

identifying information about events in other episodes similar to an event in the television program being watched;

extracting the information about events in other episodes from the website;

and

transmitting the information about events in other episodes over a network.

However, in an analogous art, Shoff discloses the identifying step (see at least 5:60-64; 11:28-34; 7:25-50); the extracting step (see at least 6:23-48); and the transmitting step (see at least FIG. 2; FIG. 4, items 74, 82; and 4:36-55) as claimed.

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It would have been obvious to a person having ordinary skill in the art at the time the invention was made to modify the supplemental information method of Ward using the episode information extraction method of Shoff for the purpose of supplying supplemental information to enhance the traditional way of viewing television.

(10) Response to Argument

A. Rejection of Claims 1-5, 8, 11, 13-16, 20 and 21 Under 35 U.S.C. § 103(a)

1. Claims 1, 20 and 21

Appellant's arguments:

Claims 1 and 20 recites "summaries" according to the combinations further recited therein. The Office Action correctly concedes that Ward does not disclose, teach or suggest this subject matter.

In order to overcome this admitted deficiency in Ward, the Office Action relies on Abroad. However, none of the disclosure, teaching or suggestions in Ahmad pertains to summaries of episodes. Rather, even assuming, *arguendo*, that the broadcasts disclosed in Ahmad correspond to episodes as recited in claims 1 and 20, Ahmad only pertains to segments of news broadcasts or entire news broadcasts, but never a summary of either a segment or a summary of an entire news broadcast. This argument, focusing on the recitation of summaries" in claims 1 and 20, is referred to below as the "first" argument.

In addition to the first argument, claims 1, 9, 20 and 21 recite "episode[s]" according to the combinations further recited therein. It is respectfully submitted that the specification makes clear that a news broadcast is outside scope of an "episode" of a television program as that term is defined according to claims 1, 9, 20 and 21. The disclosure, teaching and suggestion of Ahmad only pertains to news broadcasts. This argument, focusing on the recitations of "episode[s]" in claims 1, 9, 20 and 21, is referred to below as the "second" argument.

For at least the foregoing reasons, claims 1, 9, 20 and 21 are patentable over Ward in view of Ahmad because Ward in view of Ahmad does not disclose each and every element recited in claims 1, 9, 20 and 21.

Regarding claim 1, the Office Action includes further discussion in section 11 on pages 3-4. The Office Action correctly identifies the first and second arguments made by the Appellant. These arguments are equally applicable to claims 9, 20 and 21, although this is not acknowledged by the Office Action.

In responding to the first of the two arguments, the Office Action appears to completely overlook the fact that Appellant's first argument focused on the recitation in claims 1 and 20 of "summaries." Instead of addressing this subject matter recited in claims 1 and 20, the Office Action's response to Appellant's first argument focuses on the definition of an episode. Thus, the Office Action's response to Appellant's first and second arguments are essentially a response only to Appellant's second argument (i.e., the Office Action is non-responsive to Appellant's first argument).

For the foregoing reasons, Appellant's rebuttal of the rejection was not addressed by the Office Action. Thus, Appellant respectfully submits that the finality of this rejection is reversible as a matter of law. Therefore, in addition to reversing the rejection, Appellant respectfully requests that the Board reverse the finality of the Office Action.

Examiner's response:

a. In response to Appellant's first argument focusing on the recitation of "summaries" in Claims 1 and 20, the examiner respectfully notes the following:

Appellant asserts that "Ahmad only pertains to segments of news broadcasts or entire news broadcasts, but never a summary of either a segment or a summary of an entire news broadcast." This statement appears to infer that the claim language of Claims 1 and 20 defines the term "summary" to be "a summarization of either a segment or a summarization of an entire episode." It is noted that the features upon which applicant relies (i.e., "summarization," "summarization of either a segment or a summary of an entire [episode]" are not recited in the rejected claim(s). Furthermore, Claims 1 and 20 recites "summaries" (not "a summarization"). Moreover, the term "summaries" *per se* is not specifically defined in the specification (see p. 2, line 9; p. 7, line 15; p. 8, line 2; p. 9, lines 9-14; p. 10, line 4; p. 11, lines 1-17). At best, "summary" is characterized as a single summary or history that condenses summaries of other episodes" (see p. 11, lines 2-3), which is known in the art of "summarization." As such, it is unreasonable to one of ordinary skill to construe a "summary" or "combining summaries" as the known "summarization."

A standard definition of the term "summary" in the Merriam-Webster Online Dictionary is "an abstract, abridgment, or compendium especially of a preceding discourse," with the definition of an abstract being "something that

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summarizes or concentrates the essentials of a larger thing or several things.” In light of this definition, Ahmad’s Headline News entitled “Insurere’ Eye Erin’s Costs” in frame 214 of FIG. 2B that “concentrates the essentials of several things,” such as the property damage claims to be paid to homeowners struck by Erin on Wednesday (1st hit), estimate not including damage caused on Thursday (2nd hit), etc. appear to meet the requirement of a summary as defined by Merriam-Webster dictionary.

b. In response to Appellant’s second argument focusing on the recitation of “episode[s]” and “combining” in Claims 1, 20 and 21, the examiner respectfully notes that following:

- i. Appellant asserts that the instant specification makes clear that a news broadcast is outside scope of an “episode” of a television program as that term is defined according to claims 1, 20 and 21. A positive statement or other alternative positive statement to that extent is nowhere found in Appellant’s disclosure as a result of a text search thereof.
- ii. Merriam-Webster’s definition, among others, of an “episode” is
 - a developed situation that is integral to but separable from a continuous narrative : **INCIDENT**;
 - or
 - an event that is distinctive and separate although part of a larger series.

According to the above two definitions that are closely related to the context of the subject matter of the invention, Ahmad’s situation/event that

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is reported on Thu, 2 August 9512:50:18PDT in FIG. 2B, i.e., the property damage claims to be paid to homeowners struck on Wed. by hurricane Erin and the situation/event that is reported on Wed., 2 August 95, 5:00:09 PDT in FIG. 2B are two integral and separable /distinctive and separate situations/events from a same larger series of events, i.e., the ravages of tropical storm Erin.

Since, Appellant's disclosure or claims do not positively exclude new broadcasts from television programs, the claimed episode is reasonably and broadly interpreted to read on Ahmad's event occurring on Wednesday (1st hit) and that occurring on Thursday (2nd hit).

iii. it is noted that Claims 1 and 20 recite specifically and merely “**combining** summaries of other episodes” rather than “combining summaries of other episodes into one summary.” Thus, by showing both the summary of event occurring on Wednesday and that occurring on Thursday in one window, Ahmad is considered to meet the claim requirement of “combining summaries of other episodes” by showing multiple episodes on a single screen.

c. In response to Appellant's argument that the Office Action appears to completely overlook the fact that Appellant's first argument focused on the recitation in claims 1 and 20 of "summaries," the examiner respectfully notes that the claimed “summaries” has been addressed in the final Office action mailed on January 26, 2007 and further clarified in the Advisory action mailed on April 26, 2007. The

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Office action does indeed mention at the bottom of p. 8 of the final Office action that in an analogous art, Ahmad discloses news summaries of different episodes (e.g., Insurer's Eye Erin's Cost is the summary of the episode dated Thu, 3 August 95 and Erin: A tropical Storm, another episode dated Wednesday, 2 August 95 of the same tropical storm Erin). As discussed in details above, the claimed "summaries" appears to read on the news summaries in Ahmad. Thus, the finality of the Office action is considered proper.

2. Claims 2-5, 8, 11 and 13-16

Appellant's arguments:

Claims 2-5 and 8 depend from claim 1 and are therefore also patentable for at least the reasons stated above in connection with claim 1, as well as for the separately patentable subject matter recited therein. Likewise, claims 11 and 13-16 depend from claim 21 and are therefore also patentable for at least the reasons stated above in connection with claim 21, as well as for the separately patentable subject matter recited therein.

Examiner's response:

Since Claims 1 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Ahmad, Claims 2-5, 8 and 11, 13-16 which depend from Claims 1 and 21, respectively, are not deemed allowable for at least the reasons as set forth above and also for the reasons stated in the final Office action regarding the features recited in each of these dependent claims.

B. Rejection of Claims 6 and 17 Under 35 U.S.C. § 103(a)

Appellant's arguments:

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The Final Office Action dated January 26, 2007, rejects claims 6 and 17 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ward, in view of Ahmad, and further in view of Shoff.

Claims 6 and 17 depend from claims 1 and 21, respectively, and are therefore also patentable for at least the reasons stated above in connection with claims 1 and 21, respectively, as well as for the separately patentable subject matter recited therein.

Examiner's response:

Since Claims 1 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Ward in view of Ahmad, Claims 6 and 17, which depend from Claims 1 and 21, respectively, are not deemed allowable for at least the reasons as set forth above and also for the reasons stated in the final Office action regarding the features recited in each of these dependent claims.

C. Rejection of Claim 9 Under 35 U.S.C. § 103(a)

Appellant's arguments:

The Final Office Action dated January 26, 2007, rejects claim 9 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Ward, in view of Shoff.

Claim 9 recites "events" several times according to the combination recited therein. With respect to this subject matter, the Office Action cites column 5, lines 60-64 of Shoff and Figure 3 depicting the "target specifications" referred to therein. Specifically, the "target specifications" disclosed in Shoff are the title, actor, network, time, stereo, and close captioning. None of the "target specifications" disclosed, taught, or suggested in Fig. 3 of Shoff correspond to events as recited in claim 9.

Further, Claim 9 recited episodes. Ward is deficient with respect to this subject matter recited in claim 9 for the reasons stated above in connection with the rejection of independent claims 1, 9 and 21 as allegedly being unpatentable over Ward in view of Ahmad. For at least the following reasons, Shoff fails to overcome the deficiencies in Ahmad and Ward described above.

In the paragraphs bridging pages 4 and 5, the Office Action responds to Appellant's arguments with respect to claim 9. However, the text included in the description column in Figure 3 of Shoff are titles of entire episodes. Because this text corresponds to titles of entire episodes, it cannot be an event "in an episode" as recited in claim 9 (emphasis added).

Additionally, it is impermissible for an Examiner to engage in hindsight reconstruction of the prior art using Applicant's claims as a template and selecting elements from references to fill the page. Rather, prior art references may be modified or combined to render obvious a subsequent invention only if there was some suggestion or motivation to do so derived from the prior art itself, the nature of the problem to be

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solved, or the knowledge of one of ordinary skill in the art. *Sibia Neurosciences*, 225 F.3d 1349, 1356 (Fed. Cir. 2000); *ATD Corp. v. Lydall, Inc.*, 159 F.3d 534, 546 (Fed. Cir. 1998).

Applicant respectfully asserts that only by the impermissible use of hindsight knowledge of Applicant's own disclosure would the Examiner have acquired a motivation to combine the teachings of the cited references according to the precise combination including certain elements and excluding certain others as necessary to achieve the subject matter according to the combinations recited in the rejected claims.

With respect to alleged motivation to combine the respected teaching of Shoff and Ward, the Office Action refers to column 1, lines 32-35 of Shoff. See the paragraph bridging pages 8 and 9 of the Office Action. However, the cited portion of Shoff only establishes a motivation to provide interactive programming content in general. In other words, the alleged motivation to combine certain specific teachings of Ward and Shoff to the exclusion of other teachings in Ward and Shoff in order to arrive at the subject matter previously recited in claim 6 and now recited in claim 9, the Office Action cites a motivation for nothing more than the entire broad field of interactive programming to which all of the claims pertain. Applicant respectfully submits that this alleged motivation is insufficient to satisfy the motivation required to arrive at the specific combination recited in claim 9.

Examiner's response:

In response to Appellant's arguments that none of the "target specifications" disclosed, taught, or suggested in FIG. 3 of Shoff correspond to events as recited in Claim 9, the examiner respectfully directs Appellant's attention to the "Description" column in FIG. 3 where it is shown for example "The Secret of Gila Junction" of "Murder She Wrote" series. "The secret of Gila Junction" can be a summarizing a title that is illustrative of the main event (e.g., the secret of Gila Junction being discovered, etc.) happening during this episode of "Murder She Wrote" series.

In response to Appellant's arguments that Ward is deficient with respect to the limitation "episodes" for the reasons discussed above in conjunction with the rejection of independent claims 1 and 21 as being unpatentable over Ward in view of Ahmad and that Shoff fails to overcome the deficiencies in Ward in view of Ahmad, the examiner respectfully notes that the claimed limitation "episodes" does read on Shoff's episode "The Secret of Gila Junction," "The Friars Club," "Delta Vega" of the program "Murder She Wrote," "Seinfeld," "star Trek Next Generation" respectively.

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In response to Appellant's argument that because the text included in the description column of FIG. 3 of Shoff are titles of entire episodes, they cannot be an event "in an episode" as recited in claim 9, the examiner respectfully refers Appellant to the two above paragraphs.

In response to Appellant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). In this instance, the step of "identifying information about event...", "extracting the information about events...", and "transmitting the information about events..." are acts that are known and can be programmed by one of ordinary skill in the art.

Furthermore, the fact that Appellant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See *Ex parte Obiaya*, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985).

In this instance, considering the alleged motivation in the context of the whole paragraph 1:32-46 of Shoff, one would not see any obvious differences between the motivation suggested in Shoff from that of Appellant (Appellant's specification, p. 2, lines 9-12) to combine the prior art in order to arrive at the claimed subject matter of the invention.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejection should be sustained.

Respectfully submitted,

/Hoang-Vu Antony Nguyen-Ba/
Primary Examiner, Art Unit 2421

Conferees :

/Christopher Grant/
Christopher C. Grant, WQAS 2420

/Andrew Y. Koenig/
Andrew Y. Koenig, SPE 2423